

would have been obvious to make the mantle layer of the claimed invention primarily out of polyamide, as taught by Rajagopalan, instead of making the mantle layer primarily out of polyurethane, as taught by Higuchi, in order to “create an intermediate layer of desired durability an to give the golf ball the spin and distance desired by the inventor.”

Applicant submits that the Examiner is practicing in impermissible hindsight. The Examiner is required to forget what he has been taught about the claimed invention and to cast his mind back to the time the invention was made, to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984), and MPEP §2141.01. If there is no teaching, suggestion, or motivation, either in the references themselves, then there is no suggestion or motivation to modify the references to achieve the claimed limitations of the present invention, and the Examiner is engaging in impermissible hindsight in stating that the claims are obvious over the applied prior art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and MPEP §2143.01. “Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination.” *Exollochem, Inc. v. Southern California Edison Co.*, 2000 U.S. App. LEXIS 22681, *28-30 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998); *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Here, the Examiner has not shown any teaching in either reference that would suggest that it is desirable to substitute polyamide for the polyurethane in the mantle layer of Higuchi. The Examiner has not shown that the properties taught in Higuchi using polyurethane could be replicated using polyamide, as such, the Examiner has not provided any teaching within the references with suggest the alleged combination. Disclosure, not non-disclosure, is the foundation of any *prima facie* determination of obviousness. Regardless of the context, the prior art must, in all circumstances, suggest the desirability of the modification before the resultant modification is rendered obvious. *MPEP* § 2143.01.

Furthermore, the Higuchi reference attempts to create a golf ball having a “soft feel” while the Rajagopalan reference is directed to creating a golf ball with greater durability, which does not typically result in a golf ball having a “soft feel.” Therefore, there is no suggestion within the references of the desirability to substitute polyamide for polyurethane in the mantle layer of the golf ball. Only Applicant’s specification teaches the desire to use a mantle layer made primarily from polyester, polyamide, polyolefin or polystyrene. However, the Examiner is not free to rely on the teachings of Applicant’s specification to establish a *prima facie* case of obviousness.

Since the references does not suggest the desirability of the alleged combination, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully requests that the rejection of claims 1 and 6-18 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

RESPONSE UNDER 37 C.F.R. § 1.116
Appln. No.: 09/667,301

Attorney Docket No.: Q60969

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Michael J. Whitehead
Registration No. 48,071

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
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